

### **REMARKS**

Claims 18, 20-35, 57-58, 60, and 69-71 are pending for consideration. In view of the following remarks, Applicant respectfully requests that this application be allowed and forwarded on to issuance.

#### **Restriction Requirement**

The Applicant reaffirms its election of claims 18, 20-35, 57-58, 60, and 69-71 for prosecution in this application.

#### **Nonstatutory Double Patenting**

Claims are rejected under non-statutory double patenting over U.S. Patent No. 6,716,102. Applicant requests that the Office hold these rejections in abeyance until the indication of allowable subject matter.

#### **35 U.S.C. § 103**

Claims 18, 20-25, 27-35, 57, 58, 60, and 69-71 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,599,194 to Smith et al. (hereinafter "Smith") in view of Microsoft® Windows98.

Claims 26, 32, and 33 stand rejected under 35 U.S.C. §103(a) as being obvious over Smith in view of Microsoft® Windows98 and further in view of Links 386 Players.

### The §103 Standard

In making out a §103 rejection, the Federal Circuit has stated that when one or more reference or source of prior art is required in establishing obviousness, “it is necessary to ascertain whether the prior art *teachings* would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitutions or other modification.” *In re Fine*, 5 USPQ 2d, 1596, 1598 (Fed. Cir. 1988). That is, to make out a prima facie case of obviousness, the references must be examined to ascertain whether the combined *teachings* render the claimed subject matter obvious. *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).

Moreover, there is a requirement that there must be some reason, suggestion, or motivation *from the prior art*, as a whole, for the person of ordinary skill to have combined or modified the references. *See, In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art *teaches away* from the claimed combination. A reference is said to teach away when a person or ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

In order for a prima facie case of obviousness to be made, the resulting combination or motivation must appear to show or suggest the claimed invention. *In re Nielson*, 2 USPQ 2d1525, 1528 (Fed. Cir. 1987).

In addition to the standard discussed above, the Office has provided a paper, available at the following link:

<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>

that describes proper and improper rejections made under §103(a). Particularly instructive is Example 17 that appears in Section V of the paper illustrating an improper §103(a) rejection which is based upon a proposed motivation that is simply too general and lacking in particularity. This example is reproduced below in its entirety for the Office's convenience:

#### **V. Examples of Improper Rejection under 35 U.S.C. 103**

Example 17: Improper rejection based upon hindsight - general motivation statement.

##### **a. The claimed invention**

The invention is drawn to a smart card containing a tracking mechanism, which tracks shopping preferences of consumers by recording the type, quantity, and dates of purchase for a pre-selected group of products. The smart card is useful in a system and method for introducing new and alternative products that are of the same type as products normally purchased by the shopper. The smart card records the shopper's purchases and submits an automatic notification to the shopper when a quantity threshold is achieved for the pre-selected products. This notification will encourage the consumer to consider alternative products by providing the consumer incentives, such as a pricing discount, to purchase an alternative product.

**Claim 1:**

A method for using a smart card in a marketing analysis program designed to introduce new products, the method comprising the steps of:

storing product information on the smart card when said products are purchased by a consumer wherein said information including type, quantity and dates of the product purchased;

identifying for each product a threshold for each of said type, quantity and dates of products purchased;

determining an incentive for an alternative product based on said threshold; and

automatically notifying said consumer when said threshold is reached for a given product identified on the smart card and providing the consumer with said incentive, whereby the incentive encourages the consumer to consider alternative products.

**b. Evidence**

Reference A discloses smart card that tracks consumer preferences by recording the type, quantity, and dates of purchase of pre-selected products to determine trends in consumer purchases. The smart card is periodically read by a scanner to determine its contents for market analysis. In return for using the smart card and participating in the marketing program, the user is provided with free product coupons for products that are normally purchased by the shopper.

Reference B discloses a traditional consumer incentive program that provides coupons for the purchase of named products based upon the consumer's purchase of those same products to promote customer loyalty.

**c. Poor statement of the rejection**

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. Reference A discloses the conventional use of a smart card to track consumer preferences and provide incentives. However, Reference A does not disclose the automatic notification to consumer providing incentives. Reference B discloses providing incentives to consumers to purchase the desired products. *It*

*would have been obvious to combine Reference A's smart card with Reference B's incentive to consumers because the combination would allow Reference A's smart card to be more efficient.*

#### **d. Analysis**

*The motivation, improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious.* Additionally, there is nothing in either of references that would suggest automatically notifying the consumer when reaching a threshold nor is there anything in either reference that would suggest the notifying step. Finally, although Reference B teaches a traditional coupon scheme to promote customer loyalty, there is no suggestion, other than applicant's disclosure, to employ this scheme to promote the introduction of new and alternative products. **The rejection is improper.**

#### **The Claims**

**Claim 18** recites a game console comprising a processor and a hard disk drive coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications.

In making out the rejection of this claim, the Office admits that Smith fails to teach a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. However, the Office argues that Microsoft® Windows 98 teaches these features and that "it would have been obvious at the time of Applicant's invention to utilize the advance file management techniques taught by Microsoft® Windows98 in order to partition a hard disk drive into separate

application regions and to make certain files inaccessible to other applications in the video game.”

The Office reasons that the motivation for this combination would be to place game data from different video games in a particular location on a hard drive such that game data and application data would be stored on the hard disk in an *organized manner* (citing to pages 80-81 and 87-90). Applicant respectfully disagrees with the Office and submits that the Office has failed to make out a *prima facie* case of obviousness.

As mentioned above, in the discussion of the §103 standard, in order for a *prima facie* case of obviousness to be made, the resulting combination or motivation must appear to show or suggest the claimed invention. *In re Nielson*, 2 USPQ 2d1525, 1528 (Fed. Cir. 1987). In this case, Microsoft® Windows98 does not teach or in any way suggest a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. As such the combination of Smith and Microsoft® Windows98 fails to show or suggest the claimed subject matter.

The first part of the excerpt cited by the Office from Microsoft® Windows98 appears to deal with the difference between the FAT16 and the FAT32 file systems. While this discussion does deal with ways in which a hard drive can be organized, there is no mention whatsoever of the ability for the hard disk drive to be configured to store application data such that data associated with a first application is inaccessible to other applications.

The second part of the excerpt from Microsoft® Windows98 cited by the Office deals with the sharing of folders and printers attached to a user's computer

with other people on a network. Applicant believes that the Office is trying to show that because Microsoft® Windows98 teaches that a user can specify that a folder or printer cannot be accessed by other users on a network, that in some way this teaches data associated with a first application is inaccessible to other applications. However, the Applicant disagrees and submits that the second part of the excerpt cited by the Office fails to teach or suggest a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. Accordingly, for at least the reasons discussed above, the Office has failed to make out a *prima facie* case of obviousness. As such, this claim is allowable.

Additionally, the Applicant submits that the Office has used hindsight reconstruction by using the claimed subject matter as a template to piece together Smith and Microsoft® Windows98. As discussed above, there is a requirement that there must be some **reason, suggestion, or motivation** from the prior art, as a whole, for the person of ordinary skill to have combined or modified the references. See, *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is impermissible to use the claimed invention as an **instruction manual or “template” to piece together the teachings of the prior art** so that the claimed invention is rendered obvious. ***One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.*** *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

In this case, Smith deals exclusively with the modification of an existing video game system whereas Microsoft® Windows98 deals with the sharing of folders and printers by a user with other people on a network. As such, these two

references appear to be completely unrelated. It appears that the Office has chosen to combine Smith with Microsoft® Windows98 merely because Microsoft® Windows98 contemplates giving a user the choice to make folders and printers accessible or inaccessible to other users on a network. Without the Applicant's disclosure as an instruction manual, there is no way that one with ordinary skill in the art would look to the excerpt cited by the Office from Microsoft® Windows98 in order to design a hard drive for a video game system. In fact, Applicant respectfully submits that given the failure of the Microsoft® Windows98 reference to supply the missing features, even had one of ordinary skill consulted this reference, such would not lead to the subject matter of this claim. For this additional reason, the Office has failed to make out a *prima facie* case of obviousness.

Additionally, Applicant submits that the Office's stated motivation to combine Smith with Microsoft® Windows98 is too general. The Office's stated motivation (i.e. to store application data in an organized manner) is akin to arguing that the combination would make for a more efficient solution. As discussed above, however, *the motivation, to improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious.* Similarly here, the Office has suggested that one would be motivated to combine Smith with Microsoft® Windows98 so that game data and application data would be stored on the hard disk in an *organized matter*. The motivation to improve the organization of a hard disk is too general because it could cover almost any



altercation contemplated and it does not address why this specific proposed modification would have been obvious.

Additionally and equally as important, Smith does not purport to have a hard disk that is unorganized such that it would benefit from improved organization. For all of the reasons discussed above, the Office has failed to make out a *prima facie* case of obviousness. As such, this claim is allowable.

**Claims 20-21** depend from claim 18 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 18, are neither disclosed nor suggested in the references cited and applied by the Office.

**Claim 22** recites a video game system, comprising:

- a processor; and
- a hard disk drive coupled to the processor, the hard disk drive having:
  - a first region to store user data that includes game data saved by a user of the video game system when the processor executes a video game;
  - and a second region to store application data that includes data specific to the video game executed by the processor, wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees.

The Smith reference fails to disclose a game console having a hard disk drive that has “a first region to store user data” and “a second region to store application data” as recited in claim 22. Further, Smith fails to disclose “wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications”. Although Smith discloses a hard disk drive, Smith does not disclose a hard disk drive that stores data in the manner recited in this claim.

In rejecting this claim, the Office cites to Fig. 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46 and 54-67, and Column 25, lines 3-22 of Smith.

Regarding Fig. 4, the figure shows an expansion device that includes a hard disk drive 206. However, Fig. 4 fails to disclose a user data region and an application region. Regarding Column 1, lines 17-18, the cited text discusses a home video game system that includes a hard disk drive. This cited text lacks any reference to a user data region and an application region.

Regarding Column 2, lines 34-38, the cited text discloses “...a mass storage device such as a hard disk drive to permit the downloading of entire games into the mass storage device.” This text fails to disclose a hard disk drive having a user data region and an application region.

Regarding Column 3, lines 40-46, the cited text discloses that the described video game system may alternatively be packaged in a common integrated housing and sold as a single unit. This disclosure does not mention the hard disk drive or its contents. Regarding Column 3, lines 54-67, the cited text mentions

that the system may start under control of a program resident on the hard disk drive. The cited text also mentions that the expansion device may include a modem and a hard disk drive, and allows a video game player to surf the World Wide Web. This cited text fails to disclose a hard disk drive having a user data region and an application region.

Regarding Column 25, lines 3-22, the cited text discusses the decryption and execution of games as well as displaying options to the user to execute various application programs. This text does not disclose a hard disk drive having a user data region and an application region.

Thus, the portions of Smith relied on by the Office fail to disclose the elements of the claim that the Office argues it does.

Furthermore, as discussed above with regards to claim 1, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98.

For all of the reasons discussed above, this claim is allowable.

**Claims 23-26** depend from claim 22 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 22, are neither disclosed nor suggested in the references cited and applied by the Office.

**Claim 27** recites a method comprising:

- identifying a game identifier associated with a video game installed in a game console, wherein the game console contains a hard disk drive;
- determining portions of the hard disk drive that are associated with the video game based on the game identifier; and

- preventing the video game from accessing portions of the hard disk drive that are not associated with the video game.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees.

The Smith reference fails to disclose “preventing the video game from accessing portions of the hard disk drive that are not associated with the video game” as recited in this claim. Although Smith discloses a hard disk drive accessed by various applications, Smith does not disclose preventing access in the manner recited in this claim.

The Office alleges “[i]nherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game.” Office Action, page 4. Applicant disagrees with this allegation. Even if this allegation were true, this does not disclose or suggest *preventing* the video game from accessing portions of the hard disk drive that are not associated with the video game. If the Office believes its inherency argument, Applicant respectfully requests that the Office produce a reference that supports it.

Accordingly, Applicant submits that the Smith reference does not disclose the elements of claim 27.

Furthermore, as discussed above with regards to claim 1, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98.

Thus, for at least these reasons, this claim is allowable.

**Claims 28-35** depend from claim 27 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 27, are neither disclosed nor suggested in the references cited and applied by the Office.

**Claim 57** recites a computer-readable medium for a game console comprising computer-executable instructions that, when executed, direct the game console to:

- associate user data with a first region of a hard disk drive contained in the game console;
- associate video game application data with a second region of the hard disk drive;
- allow a video game application to access particular portions of the first region that are associated with the video game application;
- allow the video game application to access particular portions of the second region that are associated with the video game application; and
- prevent the video game application from accessing portions of the first region and the second region that are associated with other applications.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees.

For reasons that are similar or analogous to those discussed above with regard to claim 27, Smith fails to disclose *preventing* the video game application from accessing portions of the first region and the second region that are associated with other applications.

Furthermore, as discussed above with regards to claim 1, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98.

Accordingly, for at least the reasons discussed above this claim is allowable.

**Claims 58 and 60** depend from claim 57 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 57, are neither disclosed nor suggested in the references cited and applied by the Office.

**Claim 69** recites a game console comprising:

- an input port for receiving input from a controller operable by a player to generate video game control signals;
- an output port for outputting a display of three-dimensional video game play graphics for a television;
- a processor for executing instructions of a video game program;
- a controller system coupled to said input port and to said processor for executing commands related to the video game control signals;
- a portable media reader for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media; and
- a fixed disk in a non-removable hard disk drive in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program, wherein:
  - upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for selecting media to execute on the game console, wherein ***the processor will not boot without initially loading the initial program read from the fixed disk***; and
  - processor executes instructions that are read from the selected media by the portable media reader.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees.

The Smith reference fails to disclose a game console in which "the processor will not boot without initially loading the initial program read from the fixed disk" as recited in this claim. Although Smith discloses a hard disk drive with applications stored thereon, Smith does not disclose that the processor will not boot without initially loading the initial program read from the fixed disk, in the manner recited in this claim. In contrast, Smith instructs as follows:

...if a game cartridge 54 is inserted into the console 52, the system will start under control of the program resident in cartridge 54. Otherwise, it will start under control of a program resident on the hard disk drive embodied in expansion device 95 as described below. Col. 3, lines 51-56.

Thus, Smith discloses a system in which the system will start under control of a program resident in cartridge 54 or under control of a program resident on the hard disk drive. Therefore, Smith does not require that a hard disk drive be present to boot the system because Smith can start under control of a program resident in a cartridge. In point of fact, this teaches directly away from the recited subject matter.

Furthermore, as discussed above with regards to claim 1, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98.

Thus, for at least these reasons, Applicant respectfully submits that claim 69 is allowable.

**Claims 70-71** depend from claim 69 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 69, are neither disclosed nor suggested in the references cited and applied by the Office.

**Conclusion**

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of discussing an appeal to the Board.

Respectfully submitted,

Dated: 2/15/06

By: 

Lance R. Sadler  
Reg. No. 38,605  
(509) 324-9256